

III. REMARKS

Applicants have considered the current Office Action with mailing date of June 13, 2006. Claims 1-20 are pending in this application. By the amendment, claims 1, 10 and 13-20 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claim 1, 12 and 14 are rejected under 35 U.S.C. §112 ¶2 as allegedly being indefinite. Claims 1 and 18 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Claims 1-6, 9, 14-16 and 18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Pub.No. 2001/0051904A1 hereafter "Nishimura." Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura in view of US Pub. No. 2003/0182391A1, hereafter "Leber et. al.". Claims 10, 12-13, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being allegedly being unpatentable over Nishimura in view of US Pub. No. 2002/0154114A1, hereinafter "Christensen et. al.". Claim 11 is being rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura in view of Leber et. al. and Christensen et. al. Applicants respectfully disagree with the Office and traverses the rejections on the following grounds.

A. OBJECTION OF CLAIMS 1, 10, 13–14, 15, 17–18, 19, 20

In the Office Action, the Office has indicated claim 17 twice in objecting to the use of “for” being an indication of intended use. Applicants respectfully seek the Office’s clarification. Claims 15, 17, 19 and 20 were objected to for the use of “for” in the body of the claims. Applicants have amended these claims to replace the same word with “to” as suggested by the Office. Consequently, Applicants also amended the verb following immediately after “for” in each of these claims in conformance with appropriate grammar. Accordingly, Applicants believe that the claims are now placed in definite form and respectfully request the Office to remove the objection.

The Office also objected to claims 1, 10, 13-14 and 17-18 as being informal with the use of “if” making the statement following immediately thereafter optional. Applicants have amended these claims to replace “if” with “in the case that” to address the Office’s concern. Accordingly, Applicants respectfully request the Office’s withdrawal of this objection.

B. REJECTION OF CLAIM 1, 12 and 14 UNDER 35 U.S.C. §112 ¶ 2

The Office has asserted that claims 1, 12 and 14 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With respect to claim 1, Applicants respectfully submit, as explained in [0026] of the current application, that each “key” in the limitation, “set of keys”, is generated by the key system 36 on the basis of data collected or displayed through the custom data form. Each “key” comprises an attribute with its corresponding value(s) that matches

the attribute. An attribute for an item, as set out in [0024], may include for example, an item type, a cost, a description, a quantity available, sale restrictions, import/export restrictions, etc. An item selected for purchase may include in its set of attributes “item-based” attributes related to the item itself and/or “purchase-based” attributes related to the purchase as a whole. Applicants believe that the forgoing explanation clarifies the use of the term “keys” and respectfully request the Office’s withdrawal of this rejection.

With respect to claim 12, Applicants respectfully request the Office’s clarification of its objecting to the limitation “obtaining custom data”, not recited therein.

With respect to claim 14, Applicants have amended the preamble of the claim to replace “for” with “of”. Applicants believe that this establishes a nexus between the preamble and the body of the claim. Accordingly, Applicants respectfully request that this rejection be withdrawn.

C. REJECTION OF CLAIMS 1 and 18 UNDER 35 U.S.C. §101

The Office has rejected claims 1 and 18 for allegedly being directed to non-statutory subject matter. Applicants have amended claim 1 to recite, *inter alia*, “[a] method of managing custom data by a computer ...”. Applicants have also amended claim 18 to recite, “[a] computer program product ... which when executed by a computer,...”. Applicants have amended independent claim 10 in the same vein as claim 1. In addition, Applicants have amended independent claim 14 to recite, *inter alia*, “[a] system ~~for~~ of managing custom data by a computer ...”. Applicants respectfully submit that the respective amendment further directs the invention to statutory subject matter. Claims 2 – 9 depend from claim 1, claims 11 – 13 depend

from claim 10, claims 15 – 17 depend from claim 14 and claims 19 – 20 depend from claim 18. Therefore, these dependent claims are also directed to statutory subject matter. Accordingly, Applicants request that the Office reconsider and withdraw this rejection.

D. REJECTION OF CLAIMS 1-6, 9, 14-16 and 18 UNDER 35 U.S.C. §102(b)

With regards to the 35 U.S.C. §102(b) rejection over Nishimura, Applicants assert that Nishimura does not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 14 and 18 Applicants submit that Nishimura fails to teach, *inter alia*, “...comparing the set of attributes to a set of keys...”.

In support of its contention to the contrary, the Office cites ¶ [0078], lines 11-15 of Nishimura that teaches a “...display section 21 ...[displaying] ... commodity specifications”. To this extent, Nishimura teaches displaying of specification information from a manufacturer server, ¶ [0018], for selection by the purchase applicant for customizing a PC but does not teach “...comparing the set of attributes to the set of keys...”, where “... the attributes include item-based attributes and purchase-based attributes...”. Claims 1, 14 and 18. In support of this contention, the Office equates “choices available for customization” in Nishimura with “keys” in the claimed invention. Applicants respectfully traverse this rationale because each key as explained in the preceding paragraph on Page 9 of this response, comprises of attributes and corresponding values where the attributes include “item-based and purchase-based attributes”. Claims 1, 14 and 18. Nishimura does not disclose or teach the use of keys or attributes that are item-based or purchase-based. Thus, the “keys” as recited in the

claimed invention are not equivalent to the Office's inference of Nishimura's "choices available for customization". Therefore, Applicants respectfully request that the Office reconsider and withdraw this rejection of claim 1, 14 and 18.

The Office further cites ¶ [0103], lines 7-9 of Nishimura where "... the purchase applicant completes the purchase procedure with reference to the purchase procedure screen on the display section 21...". In contrast, the claimed invention includes "...displaying a custom data form in the case that the set of attributes matches the set of keys". Claim 1. As such, the display section 21 in Nishimura does not involve matching attributes to keys as in the claimed invention, but rather displays information when available. Accordingly, Applicants request that the rejection be withdrawn.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of this rejection.

E. REJECTION OF CLAIMS 7, 8, 10–13, 17 and 19–20 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Nishimura in view of Leber et. al., Applicants respectfully submit that the cited references do not disclose or suggest each and every feature of the claimed invention. In addition to the reasons set out in the preceding paragraphs on Nishimura with respect to independent claims 1, 14 and 18, Applicants further assert that Leber et. al. is non-analogous to Nishimura because Leber et. al. does not teach displaying of specification information from a

manufacturer server, ¶ [0018] in Nishimura, for customizing a PC. Specifically, Leber et. al. teaches "...a system that combines ...a chat-bot application ... an instant messaging agent ...to establish ...and interact with the chat-bot application the same way the user would interact with a human person...". ¶ [0030-0034]. Since Leber et. al. teaches in a different field from the invention a person of ordinary skill in the art looking at managing a custom data by "...determining a set of attributes for the item...comparing the set of attributes to a set of keys; and displaying a custom data form in the case that the set of attributes matches the set of keys." (claim 1), would not turn to a reference that teaches away from the intended path of the invention. To this extent, a person of ordinary skill would not look to Leber et. al. to cure the deficiencies in Nishimura. Without any motivation to combine the two references, claims 7 and 8 being dependent on claim 1, would not have been obvious to a person skilled in the art. Accordingly, Applicants requests the Office's withdrawal of the rejection.

In addition to the above, Applicants assert the combined teachings of Nishimura and Christensen *et. al.* do not teach each and every feature of the claimed invention. For example, on pages 10 - 13 of the current Office Action, the Office admits that Nishimura does not teach a series of limitations of the claimed invention, one of which is "...obtaining custom data using at least one input field in the custom data form...". Claim 10. Instead, the Office cites ¶ [0049], lines 21-25 of Christensen et. al. to remedy Nishimura's deficiency. According to the cited paragraph, Christensen et. al. teaches selecting a 'customized product' option...with the actual order process... [where] information may be transmitted directly from the logistics system 512 to the graphics module". The Office content the "selected options" in Christensen *et. al.* is equivalent to

“input fields” in claim 10. Applicants respectfully traverse this rationale because the “input fields” in the custom data form are associated with attributes of the purchased item which may be “...item-based attributes or purchase-based attributes...”. Claim 10. In contrast, Christensen’s “selected options” are inventory information of components provided to a user to select components for customizing a product but does not teach or suggest purchase-based attributes of an item. Accordingly, Applicants respectfully request that the Office withdraw this rejection and allow claim 10.

With regard to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to currently amended claims 1, 10, 14 and 18 and asserts that all claims dependent on the respective independent claims are patentable over the cited references for one or more additional unique features. Accordingly, Applicants respectfully request that the Office withdraw the rejections of all claims.

IV. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique feature. To this extent, Applicants do not acquiesces to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



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